RECEIVED
CENTRAL FAX CENTER
DEC 29 2004

PATENT

MS149613.02/MSFTP105USA

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence (along with any paper referred to as being attached or enclosed) is being transmitted *via* facsimile on the date shown below to: (703) 872-9306, Mail Stop Appeal Brief-Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

12-29-04
Date:

Himanshu S. Amin

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of:

Applicant(s): Gregory L. Meredith, *et al.*

Serial No: 09/620,771

Filing Date: July 21, 2000

Examiner: Beth Van Doren

Art Unit: 3623

Title: LONG RUNNING TRANSACTION INTEGRATION WITH SELECTIVE DEHYDRATION AND SELECTIVE COMPENSATION

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY BRIEF

Dear Sir:

Applicants' representative submits this Reply Brief in response to the Examiner's Answer dated November 22, 2004. A credit card payment form is filed concurrently herewith in connection with all fees due regarding this document and the Request for Oral Hearing. In the event any additional fees may be due and/or are not covered by the credit card, the Commissioner is authorized to charge such fees to Deposit Account No. 50-1063[MSFTP105USA].

REMARKS

Claims 1-52 are currently pending in the subject application and are presently under consideration. Favorable reconsideration of the subject patent application is respectfully requested in view of the comments herein.

I. Rejection of Claims 1-5, 7-15, 17-23, 25-36, 38-43, and 45-52 Under 35 U.S.C. §102(b)

Claims 1-5, 7-15, 17-23, 25-36, 38-43, and 45-52 stand rejected under 35 U.S.C. §102(b) as being anticipated by Srinivasan (U.S. 5,548,506). Withdrawal of this rejection is respectfully requested for at least the following reasons. Srinivasan does not teach or suggest each and every element as set forth in the subject claims.

> A single prior art reference anticipates a patent claim only if it expressly or inherently describes each and every limitation set forth in the patent claim. *Trintec Industries, Inc., v. Top-U.S.A. Corp.*, 295 F.3d 1292 (Fed. Cir. 2002). "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226 (Fed. Cir. 1989).

Independent claims 1, 11, 30 and 32 recite initiating an action within a schedule, wherein a latency attribute of the action is compared with a latency threshold and data associated with the schedule is selectively stored based on the comparison. Srinivasan does not teach or suggest such aspects. In the Examiner's Answer (dated November 22, 2004), it is asserted that Srinivasan discloses an action within a schedule that is associated with tasks with start and finish dates and a time oriented element representing the status of each task, and that this teaches the latency attribute as recited in the subject claims. However, this assertion implies that Srinivasan teaches a latency attribute associated with a status representation of tasks (an element representing the status of each task), and not the action. In contrast, the subject claims recite a latency attribute that is associated with an initiating action. Thus, the time oriented element

representing the status of each task as disclosed in Srinivasan does not teach or suggest the latency attribute as recited in the subject claims.

It is further asserted that the action disclosed in Srininvasan is sending a reminder and that the status representation attribute satisfies the term "latency" in that it is associated with the reminder, which is present and capable of occurring, though not active, but becomes active at a point, or time value, above which it is sent. As noted in the preceding paragraph, the Examiner's assertion implies that Srinivasan teaches a latency attribute associated with a status representation of tasks, not an action as recited in the subject claims. Even if the latency attribute were associated with the reminder, Srinivasan would not teach or suggest the subject claims. The subject claims recite a latency attribute associated with an initiating action. As known by one of ordinary skill in the art, an "initiating action" is an action that has commenced or begun. Thus, the latency attribute recited in the subject claims refers to a latency attribute associated with an action that has commenced and not a reminder, as disclosed in Srininvasan, which is inactive, but capable of occurring. This interpretation is consistent with Applicants' utilization of the term "latency" in the Detailed Description of the Application, which provides that a latency attribute represents a duration of time that it will take an initiating action to complete. (*See* Application, p.10, ll.26-27). (*See Markman v. Westview Instruments*, 52 F.3d 967, 980 (Fed. Cir. 1995) (en banc), *aff'd*, 517 US 370, (1996) (holding that patent office personnel must rely on the applicants' disclosure to properly determine the meaning of terms used in the claims.); *Toro Co. v. White Consolidated Industries Inc.*, 199 F.3d 1295, 1301 (Fed. Cir. 1999) (explaining the meaning of words used in a claim is construed "in the context of the specification and drawings."). *In re Zletz*, 893 F.2d 319, 321-22 (Fed. Cir. 1989) (holding patent office personnel are to give claims their broadest reasonable interpretation ***in light of the supporting disclosure***) (Emphasis added). *See also* MPEP §2106 (stating a definition of a term provided by an applicant will control interpretation of the term as it is used in the claim).

Moreover, the assertion that sending a reminder as taught by Srinivasan is synonymous with the action as recited in the subject claims is incorrect. The subject claims recite initiating an action, comparing a latency attribute associated with an initiated action with a latency threshold, and selectively storing data based upon this comparison. In contrast, Srinivasan teaches comparing a representation of a task status with a reminder range and sending a task start or finish reminder based on the comparison. Thus, unlike the subject claims that recite a latency

attribute of a running (initiating) action is compared with a threshold to determine whether data is stored, Srinivisan teaches a task status is compared with a start/finish reminder range and the result may invoke a dormant reminder to remind a user of the start/finish date.

It is further asserted in the Examiner's Answer that Srinivasan discloses comparing the status representation with a reminder window and that this teaches comparing the latency attribute of the action with a latency threshold as recited in the subject claims. As described in detail above, the task status representation disclosed in Srinivasan does not teach or suggest a latency attribute as recited in the subject claims. The Examiner contends the term "latency" is satisfied by the reminder window in that a reminder is present and capable of occurring, though not active, but becomes active at a point, or time value, above which it is sent. This argument fails since Applicants' Detailed Description provides that a latency threshold relates to a point where a system will wait for an initiating action to complete, not a range that determines whether a task start or finish date is sent in a reminder message. (*See* Application, p.10, ll.24-26). (*See Markman v. Westview Instruments*, 52 F.3d 967, 980 (Fed. Cir. 1995) (en banc), *aff'd*, 517 US 370, (1996) (holding that patent office personnel must rely on the applicants' disclosure to properly determine the meaning of terms used in the claims.); *Toro Co. v. White Consolidated Industries Inc.*, 199 F.3d 1295, 1301 (Fed. Cir. 1999) (explaining the meaning of words used in a claim is construed "in the context of the specification and drawings."). *In re Zletz*, 893 F.2d 319, 321-22 (Fed. Cir. 1989) (holding patent office personnel are to give claims their broadest reasonable interpretation ***in light of the supporting disclosure***) (Emphasis added). *See also* MPEP §2106 (stating a definition of a term provided by an applicant will control interpretation of the term as it is used in the claim). In addition, it is well known in the art that the term "threshold" and the term "window" are not synonyms; a threshold represents a cross-over point whereas a window represents a range. The Examiner is reminded that for a prior art reference to anticipate pursuant to 35 U.S.C. §102 each and every element as set forth in the claim must be "identically shown in a single reference." (*See In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999) (*quoting Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 631 (Fed. Cir. 1987)).

It is further asserted in the Examiner's Answer that Srinivasan teaches selectively storing initiated action related data based on a latency attribute / latency threshold comparison as recited in the subject claims. As support for this assertion, the Examiner provides that once a reminder is sent, the task leader can return schedule updates that are subsequently utilized to update a

project database. Even if this were correct, it does not teach or suggest the subject claims. Srinivasan teaches a task status is compared with a start/finish reminder range and the result may invoke a dormant reminder to remind a user of the start/finish date. Thus, unlike the comparison recited in the subject claims which results in selective storage initiated action related data, the comparison taught in Srinivasan does not result in such selective data storage.

Independent claims 40 and 46 recite recognizing a transaction boundary and selectively compensating a first action within a schedule based on the transaction boundary and a compensating parameter based on an abortion of a second action. In the Examiner's Answer, it is asserted that Srinivasan discloses that when a task stops prematurely, a reminder associated with the task also stops prematurely, and the schedule is rebuilt to compensate for these premature endings. The Examiner contends this teaches the subject claims. However, Strinivasan does not teach or suggest prematurely stopping reminders or rebuilding a project schedule to compensate for tasks terminating prematurely. Instead, Srinivasan teaches that tasks have start and finish dates and that reminders for pending tasks (tasks with start/finish dates falling within a specified range or window) are sent to remind task leaders, work team members, *etc.* of these dates. Thus, premature termination of a task does not prematurely stop a reminder from executing, but rather a reminder is sent depending on the status of the task. Srinivasan further teaches that the project schedule may be rebuilt based on information received from users. Thus, premature termination of a task does not elicit a rebuild. Rather, user provided information such as priority information or task status information may lead to a project schedule rebuild.

Independent claims 51 and 52 recite determining action and transaction states and a relationship between the action and transaction based on a transaction boundary and compensating an operation when the states of the action and transaction are related and have aborted. In the Examiner's Answer, it is asserted that claim 51 does not recite the term "operation." Applicants' representative respectively submits that the term "operation" is recited in both claims 51 and 52, respectively, in the second to last sentences of their last paragraphs – "... performing an ***operation*** according to the compensation routine associated with the transaction." (Emphasis added). In addition and as discussed *supra* Srinivasan does not teach of suggest selectively compensating actions as recited in the subject claims.

In view of the above, it is respectfully requested that the rejection of independent claims 1, 11, 30, 32, 40, 46, 51 and 52 (and claims 2-5, 7-10, 12-15, 17-23, 25-29, 31, 33-36, 38-39, 41-43, 45, and 47-50, which depend therefrom) be withdrawn.

II. Rejection of Claims 6, 16, 24, 37, and 44 Under 35 U.S.C. §103(a)

Claims 6, 16, 24, 37, and 44 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Srinivasan (U.S. 5,548,506). It is respectfully submitted that this rejection should be withdrawn for at least the following reasons. Claims 6, 16 and 24, 37, and 44 depend from independent claims 1, 11, 32 and 40, respectively, and by virtue of their dependency, these claims contain all the limitations of their respective base claims and, therefore, are allowable for the reasons discussed *supra*.

CONCLUSION

The present application is believed to be in condition for allowance in view of the above comments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063.

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicants' undersigned representative at the telephone number below.

Respectfully submitted,

AMIN & TUROCY, LLP

Himanshu S. Amin
Reg. No. 40,894

AMIN & TUROCY, LLP
24TH Floor, National City Center
1900 E. 9TH Street
Cleveland, Ohio 44114
Telephone (216) 696-8730
Facsimile (216) 696-8731